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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/816,967	04/02/2004	Werner Holzl	HM/5-22028/A/CONT 2	1686

7590 06/15/2005

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EXAMINER

KEYS, ROSALYND ANN

ART UNIT PAPER NUMBER

1621

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/816,967

Applicant(s)

HOLZL ET AL.

Examiner

Rosalynd Keys

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 22-33 and 37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-33 and 37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Status of Claims*

1. Claims 22-33 and 37 are pending.  
Claims 22-33 and 37 are rejected.  
Claims 1-21, 34-36 and 38 are cancelled.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 22-33, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muntwyler et al. (US 4,268,693) in view of Silverman (The Organic Chemistry of Drug Design and Drug Action, 1992, pages 15-19, in particular Table 2.2 on page 19), for the reasons given in the previous office action, mailed December 13, 2004.
5. Claims 22, 23, 33, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Troesken et al. (DE 2538016 A1), for the reasons given in the previous office action, mailed December 13, 2004.
6. Claims 22, 23, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujikawa et al. (Yakugaku Zasshi, Vol. 91(9), pp. 930-933, 1971), for the reasons given in the previous office action, mailed December 13, 2004.

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7. Claims 22-25, 27, 30-33 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leichlingen et al. (US 3,753,914), for the reasons given in the previous office action, mailed December 13, 2004.

### ***Response to Amendment***

#### ***Claim Rejections - 35 USC § 112***

8. The rejection of claim 37 under 35 U.S.C. 112, first paragraph, is withdrawn

9. The rejection of claim 37 under 35 U.S.C. 112, second paragraph, is withdrawn.

#### ***Claim Rejections - 35 USC § 102***

10. The rejection of Claim 22 under 35 U.S.C. 102(b) as being anticipated by Troesken et al. (DE 2538016 A1) is withdrawn.

### ***Response to Arguments***

#### ***Claim Rejections - 35 USC § 103***

11. Applicant's arguments, see pages 7 to 9, filed March 16, 2005, with respect to the 35 USC 103(a) rejection based upon Jackson et al. (US 4,980,153) have been fully considered and are persuasive. The rejection of 22-24, 28, 29, 31, 33 and 37 has been withdrawn.

***Rejection of claims 22-33, and 37 under 35 U.S.C. 103(a) as being unpatentable over Muntwyler et al. (US 4,268,693) in view of Silverman (The Organic Chemistry of Drug Design and Drug Action, 1992, pages 15-19, in particular Table 2.2 on page 19)***

12. The Applicants arguments Applicant's arguments filed March 16, 2005 have been fully considered but they are not persuasive because the compounds of Muntwyler et al. and the compounds of the instant invention are structurally similar and they have similar utilities. Thus, there is a motivation to make the claimed compounds. See *In re Payne*, 606 F.2d 303, 313, 203

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USPQ 245, 254 (CCPA 1979). Further the precise difference between the compounds of Muntwyler and the instant compounds involves a known isosteric replacement thus providing a reasonable expectation of success. The argument that Muntwyler teaches away from the instant invention is not persuasive because it is based upon the teaching of Muntwyler alone and not upon its combination with Silverman. See *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981), wherein it is taught that non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references.

For the above reasons this rejection is maintained.

Rejection of Claims 22, 23, 33 and 37 under 35 U.S.C. 103(a) as being unpatentable over Troesken et al. (DE 2538016 A1)

13. The Applicants arguments filed March 16, 2005 have been fully considered but they are not persuasive because although R2 is not disclosed as being an alkoxy it is disclosed as being a C1-C20 alkyl. Thus, not only is the instant compound still obvious over compound 7, but it is also obvious over compound 14 for the same reasons. Further, there are not multiple structural differences between the instant compound and compound 7 of Troesken et al. The only difference between the instant compound and that of compounds 7 and 14 is the position of the OH group. The obviousness of this difference has already been discussed in the previous office action, mailed December 13, 2004. Said obviousness has not been overcome because the Applicants have not shown any unexpected results and/or unexpected beneficial properties.

For the above reasons this rejection is maintained.

Rejection of claims 22, 23, and 33 under 35 U.S.C. 103(a) as being unpatentable over Fujikawa et al. (Yakugaku Zasshi, Vol. 91(9), pp. 930-933, 1971)

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14. The Applicants arguments filed March 16, 2005 have been fully considered but they are not persuasive because the claims do not require the compounds of Fujikawa et al. to be general-purpose antibiotics. The claims are directed to an antimicrobial method comprising contacting a substrate with an antimicrobially effective amount of the claimed hydroxyphenyl ether compound. In Fujikawa the sake is the substrate and the antimicrobial compound that is used is structurally similar to the instant compounds except for the placement of substituents in the ring. The obviousness of this difference has already been discussed in the previous office action, mailed December 13, 2004. Said obviousness has not been overcome because the Applicants have not shown any unexpected results and/or unexpected beneficial properties.

For the above reasons this rejection is maintained.

Rejection of claims 22-25, 27, 30-33 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leichlingen et al. (US 3,753,914)

15. The Applicants arguments filed March 16, 2005 have been fully considered but they are not persuasive because the Examiner believes that a prima facie case of obviousness has been shown for the reasons given in the previous office action.

For the above reasons this rejection is maintained.

### **Conclusion**

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

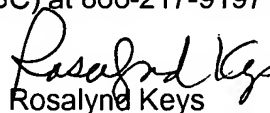
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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosalynd Keys whose telephone number is 571-272-0639. The examiner can normally be reached on M and F 3:00-8:00 pm and T-TR 5:30-10:30 am.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Rosalynd Keys  
Primary Examiner  
Art Unit 1621

June 12, 2005